

REMARKS

In the present Amendment, claim 1 has been amended to incorporate the subject matter of claim 12. Claim 12 has been canceled.

Claims 3 and 4 have been amended to replace “.” in the body of the claims with --:--.

Claim 4 has been amended to correct a typographical error, by replacing “-C(R₁₉)(R₂₀)(R₂₂)” with -- -C(R₁₉)(R₂₀)(OR₂₂)--. This amendment is supported by Applicants’ priority document JP 2001-079184, for example, in claim 4. The priority document is incorporated by reference in the last paragraph of the present specification.

Claims 2 and 4 have been amended to delete the extra term “group.”

Claims 17-37 have been added as new claims. New independent claim 17, and new independent claims 24 and 31, are supported by the specification, for example, in original claims 1 and 3, and original claims 1 and 4, respectively. Claims 18, 25 and 32 correspond to original claim 2 but depend from new claims 17, 24 and 31, respectively. Claims 26 and 33 correspond to original claim 3 but depend from new claims 24 and 31, respectively. Claim 19 corresponds to original claim 4 but depends from new claim 17. Claims 20, 27 and 34 correspond to original claim 5 but depend from new claims 17, 24 and 31, respectively. Claims 21, 28 and 35 correspond to original claim 6 but depend from new claims 17, 24 and 31, respectively. Claims 22, 29 and 36 correspond to original claim 7 but depend from new claims 17, 24 and 31, respectively. Claims 23, 30 and 37 correspond to original claim 12 but depend from new claims 17, 24 and 31, respectively.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appl. No.: 10/099,981
Attorney Docket No.: Q69083

No new matter has been added and entry of the Amendment is respectfully requested. Upon entry of the Amendment, claims 1-11 and 13-37 will be all of the claims pending in the application.

In Paragraph No. 2 of the Action, claims 1, 2 and 4-14 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Allen et al (US Pat. No. 6,610,456). Further, in Paragraph No. 4 of the Action, claims 15 and 16 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Allen et al.

Applicants respectfully submit that the claims as amended are not anticipated or rendered obvious over Allen et al for at least the following reasons.

The composition of the present invention comprises a specific resin containing a fluorine atom and a specific surfactant containing at least one of a fluorine atom and a silicon atom. By the constitution of the present invention, specific effects are achieved, including superior developing performance free of development defects, as well as desirable coating properties are achieved. These effects are further demonstrated in the working examples of the present specification.

Allen et al, however, does not disclose or suggest the use of a fluorine- or silicon-containing surfactant.

Accordingly, Allen et al does not disclose or suggest the presently claimed resist composition comprising a specific resin and a specific surfactant, nor the specifically excellent effects of superior developing performance free of development defects, as well as desirable coating properties of the present invention.

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Further, Applicants respectfully submit that new claims 17-37 are not anticipated or rendered obvious over Allen et al for the following additional reasons.

Claims 17-23 incorporate the subject matter of original claim 3 which is not included in the rejections. Claims 17-30 recite a repeating unit of the formula (I) wherein R₄ is not a hydrogen atom, which is not disclosed or suggested by Allen et al. Claims 31-37 recite a repeating unit of formula (VII), which is not disclosed or suggested by Allen et al.

In view of the above, Applicants respectfully submit that the present invention is novel and patentable over Allen et al, and the rejections should be withdrawn.

In Paragraph No. 5 of the Action, claims 1, 2 and 4-14 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Aoai et al (US Pub. No. 2002/0061464). Further, in Paragraph No. 6 of the Action, claim 3 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Aoai et al.

Applicants herewith submit a sworn English translation of their priority document, i.e., JP 2001-079184, to obtain the benefit of their priority claim. The priority date of March 19, 2001 of the present invention is prior to the September 25, 2001 date of Aoai et al. Accordingly, Aoai et al is not prior art against the present claims. Support for the present claims 1-14 in JP 2001-079184 is summarized below:

Present Claims	JP 2001-079184
1-7	claims 1-7, respectively
8	page 27, 1st full paragraph
9-10	page 41, 2nd full paragraph

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11	page 72, 1st full paragraph
12	page 76, 1st paragraph
13	claim 8
14	page 12, 1st full paragraph

Further, Applicants state that Aoai et al and the present invention were both owned by the same assignee, i.e., Fuji Photo Film Co. Ltd., at the time the present invention was made.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejections.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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